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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,277	09/25/2001	Ralf M. Luche	200125.434	9940

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EXAMINER
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YU, MISOOK

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/964,277

Applicant(s)

LUCHE ET AL.

Examiner

MISOOK YU, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-98 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to SEQ ID NO:2 polypeptide, classified in class 435, subclass 183.
- II. Claims 2-9, 11-14, drawn to polypeptide encoding SEQ ID NO:2, vector, host cells, method of making protein using said host cells, classified in class 536, subclass 23.2 and others.
- III. Claims 10, 22-25, drawn to method of detecting the product of group II using primers and antisense, antisense, classified in class 435, subclass 6, and others.
- IV. Claims 15-16, drawn to antibody, classified in class 536, subclass 387.1.
- V. Claims 18-21, drawn to method of detecting the product of group I using the antibody of group IV above, classified in class 435, subclass 7.1.
- VI. Claims 26-29, drawn to screening useful agents using the product of group I, classified in class 435, subclass 4.
- VII. Claims 30-32, drawn to screening useful agents using the product of group II, classified in class 435, subclass 4.
- VIII. Claims 33, and 36-42 in part, drawn to method for modulating a proliferative response in a cell using an agent, unclassifiable due to the agent has to be screened first by the method of group V1 and VII.

- IX. Claims 34, and 36-42 in part, drawn to method for modulating a differentiation of a cell using an agent, unclassifiable due to the agent has to be screened first by the method of group V1 and VII.
- X. Claims 35, and 36-42 in part, drawn to method for modulating a survival of a cell using an agent unclassifiable due to the agent has to be screened first by the method of group V1 and VII.
- XI. Claims 43 and 44, drawn to method of treating many disorders with an undisclosed and/or unknown compound, unclassifiable due to the agent has to be screened first by the method of group V1 and VII.
- XII. Claims 45 and 46, drawn to a DSP-16 substrate trapping mutant, classified in class 435, subclass 183.
- XIII. Claims 47-49, drawn to method of screening SEQ ID NO:2 interacting partners, classified in class 435, subclass 5.
- XIV. Claim 50, drawn to SEQ ID NO:21 polypeptide, classified in class 435, subclass 183.
- XV. Claims 51-58,60-63, drawn to polypeptide encoding SEQ ID NO:21, vector, host cells, method of making protein using said host cells, classified in class 536, subclass 23.2 and others.
- XVI. Claims 59, 71-74, drawn to method of detecting the product of group XV using primers and antisense, antisense, classified in class 435, subclass 6, and others.
- XVII. Claims 64-66, drawn to antibody, classified in class 536, subclass 387.1.

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- XVIII. Claims 67-70, drawn to method of detecting the product of group XIV using the antibody of group XVII above, classified in class 435, subclass 7.1.
- XIX. Claims 75-78, drawn to screening useful agents using the product of group XIV, classified in class 435, subclass 4.
- XX. Claims 79-81, drawn to screening useful agents using the product of group XV, classified in class 435, subclass 4.
- XXI. Claims 82, 85-91 in part, drawn to method for modulating a proliferative response in a cell using an agent that modulates group XIV product's activity, unclassifiable due to the unknown nature of the agent.
- XXII. Claims 83, and 85-91 in part, drawn to method for modulating a differentiation of a cell using an agent that modulates group XIV product's activity, unclassifiable due to the unknown nature of the agent.
- XXIII. Claims 84, and 85-91 in part, drawn to method for modulating a survival of a cell using an agent that modulates group XIV product's activity, unclassifiable due to the unknown nature of the agent.
- XXIV. Claims 92 and 93, drawn to method of treating many disorders with an undisclosed and/or unknown compound that modulates group XIV product's activity, unclassifiable due to the unknown nature of the agent.
- XXV. Claims 95, drawn to SEQ ID NO:21 mutant, classified in class 435, subclass 183.

XXVI. Claims 96-98, drawn to method of screening SEQ ID NO:21 interacting partners, classified in class 435, subclass 5.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and VI, XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of group VI or XIII.

Inventions XIV and XIX, XXVI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of XIX or XXVI.

Inventions II and III, VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of III or VII.

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Inventions XV and XVI, XX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of XVI or XX.

Inventions IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as purifying the binding protein.

Inventions XVII and XVIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as purifying the binding protein.

Inventions VIII-XI and XXI-XXIV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different

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modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the different inventions have different effects.

Inventions XII and XXV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the different products have different functions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 703-



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308-2454. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu  
September 6, 2003

  
ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600